

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID D. KOESTER,
GLENN A. BENSON,
and KURT J. KORKOWSKI

Appeal 2007-0033
Application 09/751,669
Technology Center 2600

Decided: November 26, 2007

Before LEE E. BARRETT, JOSEPH F. RUGGIERO,
and MAHSHID D. SAADAT, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 13, 17, and 18. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' claimed invention relates to a disc drive having an actuator with a machined external peripheral surface that extends along the entire periphery of the actuator. The machined external peripheral surface entirely defines a desired profile dimension of the actuator. (Specification 4).

Claim 13 is illustrative of the claimed invention and reads as follows:

13. A disc drive comprising an actuator with a machined external peripheral surface extending along an entire periphery of the actuator and comprising a desired profile dimension entirely defined by the machined external peripheral surface.

The Examiner relies on the following prior art references to show unpatentability:

| | | |
|----------|-----------------|--|
| Brar | US 5,156,919 | Oct. 20, 1992 |
| Born | US 5,930,581 | Jul. 27, 1999 |
| Williams | US 6,538,853 B1 | Mar. 25, 2003 (filed Sep. 13, 1999) |

Claim 13 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Williams. Claim 13 also stands rejected under 35 U.S.C. § 102(b) as being anticipated by Born. Claims 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over either one of Williams or Born in view of Brar.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs and Answer for the respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to

make in the Briefs have not been considered and are deemed to be waived [see 37 C.F.R. § 41.37(c)(1)(vii)].

ISSUES

- (i) Under 35 U.S.C § 102(e), does Williams have a disclosure which anticipates the invention set forth in claim 13?
- (ii) Under 35 U.S.C § 102(b), does Born have a disclosure which anticipates the invention set forth in claim 13?
- (iii) Under 35 U.S.C § 103(a), with respect to appealed claims 17 and 18, would the ordinarily skilled artisan have found it obvious to modify either one of Williams or Born by adding Brar to render the claimed invention unpatentable?

PRINCIPLES OF LAW

1. ANTICIPATION

It is axiomatic that anticipation of a claim under § 102 can be found if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565

(Fed. Cir. 1992). Anticipation of a patent claim requires a finding that the claim at issue “reads on” a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

2. OBVIOUSNESS

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

ANTICIPATION REJECTIONS UNDER 35 U.S.C. § 102

With respect to the 35 U.S.C. § 102(e) rejection of independent claim 13 based on Williams, the Examiner indicates (Answer 4) how the various limitations are read on the disclosure of Williams. In particular, the Examiner directs attention to the illustration in Figure 1B of Williams, which is described beginning a column 1, line 59 of Williams.

Appellants' arguments in response assert that the Examiner has not shown how each of the claimed features is present in the disclosure of Williams so as to establish a *prima facie* case of anticipation. Appellants' arguments focus on the contention that, in contrast to the language of independent claim 13, Williams does not disclose an actuator with a machined external peripheral surface wherein a desired profile dimension is entirely defined by the machined external peripheral surface.

According to Appellants (App. Br. 5-7; Reply Br. 1-3), the E-block manufacturing process described by Williams is typical of what Appellants have disclosed as being in the prior art, i.e., the E-block part is extruded or cast and, subsequently, extraneous material is cut or machined away. In Appellants' view, this prior art manufacturing process results in the E-block peripheral surface shape being defined by the extrusion or casting process with the desired profile dimensions not being "entirely defined" by any machined external peripheral surface as claimed.

We do not find Appellants' arguments to be persuasive. While we do not necessarily agree with the Examiner's position (Answer 4 and 6) that the word "machined" in the claimed phrase "machined external peripheral

surface” can be disregarded as a mere product-by-process limitation, we do agree with the Examiner’s ultimate finding that all of the elements of appealed claim 13 are disclosed by Williams.

In making this determination, we simply find no evidence on the record before us to support Appellants’ contention that the E-block manufacturing process disclosed by Williams is typical to what is described by Appellants’ disclosure (Specification 3) as being in the prior art. Williams does disclose (col. 10, ll. 40-51) a “casting” process in which a rough E-block is removed from a casting mold and the actuator arms machined to the desired dimensions. It is significant, however, that this casting process is disclosed by Williams as being an alternative to an earlier disclosed extrusion process. As disclosed by Williams (col. 10, ll. 31-34), “[f]or example, the E-block 16 could be extruded and machined to the proper dimensions.” (Emphasis added). In our view, absent any indication by Williams that only part of the E-block is machined to proper dimensions, the skilled artisan would reasonably conclude that the entire E-block 16, including the external peripheral surface as claimed, is being machined to the desired dimensions.

We further find to be without merit Appellants’ arguments directed to the Examiner’s separate anticipation rejection of independent claim 13 based on Born. As with the previously discussed Williams reference, Appellants contend (App. Br. 8: Reply Br. 3) that the machining manufacturing process disclosed by Born is limited merely to the removal of excess material between the actuator arms, i.e., machining is not performed around the entire periphery of the actuator as claimed.

We agree, however, with the Examiner's analysis set forth in detail at page 7 of the Answer. As explained by the Examiner, Born discloses (col. 3, ll. 33-65) that the actuator assembly includes three portions, a voice coil yoke, an aluminum body, and an actuator arm. Within this description, Born discloses that each of these actuator assembly portions is machined to their desired dimensions. Again, as with Williams, it is our opinion that, absent any disclosure by Born that certain surfaces are being excluded from machining, the skilled artisan would reasonably conclude that the entirety of the peripheral surfaces of each of the arm assembly portions is machined and, as a result, the entire peripheral surface of the actuator arm assembly is being machined.

In view of the above discussion, since all of the claimed limitations are present in the disclosure of each one of Williams and Born, the Examiner's 35 U.S.C. § 102(e) and 35 U.S.C. § 102(b) rejections, respectively, of appealed independent claim 13 is sustained.

35 U.S.C. § 103(a) REJECTION

Appellants' arguments in response (App. Br. 9-10; Reply Br. 3-4) to the Examiner's obviousness rejection of dependent claims 17 and 18 based on the combination of either one of Williams or Born in view of Brar reiterates those arguments made alleging the deficiencies of Williams and Born in disclosing the machining of an entire periphery of an actuator. For all of the reasons discussed, *supra*, we find such arguments to be unpersuasive.

We also find no error in the Examiner's finding (Answer 5-8) that the skilled artisan would have found it obvious to apply the 0.003 inch machining tolerance level teachings of Brar to the devices of Williams or Born. Accordingly, since the Examiner's *prima facie* case of obviousness has not been overcome by any convincing arguments from Appellants, we sustain the Examiner's 35 U.S.C. § 103(a) rejection of dependent claims 17 and 18.

CONCLUSION

In summary, we have sustained the Examiner's rejections of all the claims on appeal. Therefore, the decision of the Examiner rejecting claims 13, 17, and 18 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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